

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Andreas NANDY et al.

Examiner: ROONEY, NORA MAUREEN

Serial No.: 10/583,089

Group Art Unit: 1644

Filed: JUNE 15, 2006

Confirmation Number: 8804

Title: **DNA SEQUENCE, AND RECOMBINANT PREPARATION OF GROUP 4 MAJOR ALLERGENS FROM CEREALS**

RESPONSE TO RESTRICTION REQUIREMENT

MAIL STOP AMENDMENT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to this Restriction Requirement mailed June 27, 2008, Applicants hereby elect, with traverse, Group II (claims 10-13), drawn to a polypeptide having the sequence(s) set forth in SEQ ID NO: 2, 4, 6, 8, 10, variants thereof, medicaments thereof and pharmaceutical compositions thereof.

In response to the election of species requirement, Applicants hereby elect, with traverse, the polypeptide having the sequence set forth in SEQ ID NO: 2.

The requirement for restriction is respectfully traversed insofar as the Office Action has not demonstrated that an undue searching burden would be required to examine all groups and certainly not to examine at least more than one of the groups (for example, Groups I and III, which are *generically* directed to the molecules of the present invention and method(s) for the production thereof and/or use thereof). For example, Applicants' specification expressly teaches that the nucleic acid molecules of Group I and vaccines/pharmaceutical compositions comprising such polynucleotides encode the polypeptide product(s) of the elected Group II. A search of the two Groups would not constitute undue burden. "If search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct invention." (Emphasis added.) See, M.P.E.P. §803.

Regarding Group III, claim 14, which is directed to a process of using the product of elected Group II, reference is made to the decisions in In re Ochiai, 37 USPQ2d 1127 (Fed. Cir. 1995), and

In re Brouwer, 37 USPQ2d 1663 (Fed. Cir. 1996). The Commissioner's comments thereon in 1184 TMOG 86, March 26, 1996, indicate that, where product and process claims in the same application have been restricted and the elected product claim has been found allowable, withdrawn process claims including the limitations of the allowed product claim will be rejoined into the application and fully examined in that same application. It is respectfully submitted that the process claims herein should be rejoined and fully examined at such time as the product claim is found allowable.

The requirement for election of species is traversed insofar as the Office Action has not demonstrated that it would constitute undue burden to examine more than one polypeptide sequence(s) which comprise the structural features of the claimed group 4 major allergens from cereals (*Triticeae*). To this end, Applicants cordially invite the Examiner to review the disclosure contained in the paragraph bridging page 4 lines 10–35 of the present specification and the disclosure contained in the sequence listing page.

Withdrawal of the restriction requirement, in its entirety, is earnestly solicited.

Should the Restriction Requirement still be maintained, Applicants will seek reentry of any withdrawn claims once allowable subject matter has been determined.

The Commissioner is hereby authorized to charge any fees associated with this response to Deposit Account No. 13-3402.

Respectfully submitted,

/Anthony J. Zelano/

Anthony J. Zelano, Reg. No. 27,969
Attorney for Applicant(s)

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

Attorney Docket No.: MERCK-3178

Date: August 19, 2008

Serial No.: 10/583,089

-2-

MERCK-3178